

### **REMARKS/ARGUMENTS**

Claims 17, 18 and 20 - 32 are currently pending.

Claims 17 and 27 are presently amended. Claims 17-32 were rejected by the Examiner. The rejections are respectfully traversed.

The Examiner rejected Claim 27 under 35 U.S.C. §112, second paragraph, as indefinite for improper antecedent basis. The Applicant has amended Claim 27 to include the phrase "thick disc" to further clarify to which steel member the phrase "steel member (13b)" is referring.

The Examiner rejected Claims 17, 18, 22, 24-26, 28-30, and 32 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,896,973 to Hochmuth et al. The Examiner indicated that Hochmuth et al. discloses "a spindle 10, a driven member 4, a freewheel having locking members 25, a ring 1, a drive member 5 having unlocking members 27 (see Fig. 2), and torque transmitting catch surfaces on projection 19 on the drive member and surfaces 28 on openings of the driven member . . . [t]he catch openings are radial recesses (or "valleys") 22 . . . [t]he cam and locking members are arranged in pairs . . . [t]he driven member 4 is force-lockingly connected to the spindle 10." The Applicant respectfully traverses the rejection.

Applicant respectfully asserts that the rejection under 35 U.S.C. §102(e) is improper since the effective priority date of the Hochmuth et al. application was May 15, 1997 and the effective priority date of the present application was August 26, 1997, and the foreign publication was not published in English as required under §102(e). The Applicant respectfully requests the rejection be withdrawn.

The Examiner rejected Claims 17, 18, 22, 24-26, 28-30, and 32 under 35 U.S.C. §102(b) as anticipated by WO 96/20352A1 to Hochmuth et al. The Examiner indicated that Hocmuth et al. discloses "a spindle 10, a driven member 4, a

freewheel having locking members 25, a ring 1, a drive member 5 having unlocking members 27 (see Fig. 2), and torque transmitting catch surfaces on projection 19 on the drive member and surfaces 28 on openings of the driven member . . . [t]he catch openings are radial recesses (or “valleys”) 22 . . . [t]he cam and locking members are arranged in pairs . . . [t]he driven member 4 is force-lockingly connected to the spindle 10.” The Applicant respectfully traverses the rejection as Hochmuth et al. (neither the reference cited for the §102(e) nor the §102(b) rejections), does not disclose a continuous, one-piece spindle nor a toothed gearwheel as a drive member supported thereon as claimed in sole independent claim 17, as amended, and therefore, all dependent claims.

Further, the Examiner has set forth in his rejection only a statement that the cited art (‘973 and WO 96/20352A1) includes only certain elements set forth in the rejected claims which do not comprise the claims in their entirety. The Examiner has by no means addressed every element contained in the claims (for example, that the driven member is “fixedly connected to said spindle” and multiple other elements set forth within Claim 17, and therefore, contained within the remaining dependent claims) and as a result has not made a prima facie case for anticipation under §102(b) since the invention of the prior art cannot be the same invention unless every element described within the claims of the present invention are also described within the prior art citation. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 338, 86 S.Ct. 335 (1965). As a result, the Applicant respectfully requests that the Examiner withdraw the rejections.

Additionally, the device disclosed in the ‘973 patent is a clamp-type locking mechanism used for adjusting a seat position (title, abstract, and throughout). As disclosed in the summary of the invention, the device of ‘973 is a “thin walled sheet

metal part”, and that it is possible to “make the walls of the sheet metal very thin”. (Col. 1, Summary of the Invention, lines 49-54.) Further, that a “cylindrical pin” is arranged coaxially to the driving element and the driven element to “ensure that the driving member is always correctly positioned coaxially with respect to the driven member and centered in relation to the housing” and that it is possible to “form a cup” instead of the pin. Clearly, the invention of ‘973 is not foreseen to serve the purposes of the present invention--a heavy duty part incorporating an operational spindle having fast rotation for rotational work tools such as drills. Neither the desired effect of utilizing “thin” sheet metal, nor the optional “cylindrical pin” disclosed which *cannot* equate to a work tool spindle, would be useful in the present invention. Further, the invention as disclosed in ‘973 requires use of a spring element (Col. 6, Claim 1; Col. 5, lines 7-24) as an integral part of its invention, thereby teaching away from the present invention. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

The Examiner has also rejected Claims 17, 21-24, and 28-30 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,794,479 to Schwarzbich. The Examiner indicated that Swarzbich includes “a spindle 26, a driven member 30, a freewheel having locking members 32, a ring 28, a drive member having unlocking members 36 and cams 38 that engage catch openings in the driven member . . . [t]he catch opening are ring segments.” The ‘479 patent does not disclose a continuous, one-piece spindle nor a toothed gearwheel as a drive member supported thereon as claimed in sole independent claim 17, as amended, and therefore, all dependent claims. The Applicant respectfully traverses the rejections.

The Examiner has set forth in his rejection only a statement that the cited art (‘479) includes certain elements set forth in the rejected claims which do not

comprise the claims in their entirety. The Examiner has by no means addressed every element contained in the claims (for example, that the driven member is "fixedly connected to said spindle" and multiple other elements set forth within Claim 17, and therefore, contained within the remaining dependent claims) and as a result has not made a prima facie case for anticipation under §102(b) since the invention of the prior art cannot be the same invention unless every element described within the claims of the present invention are also described within the prior art citation. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 338, 86 S.Ct. 335 (1965). As a result, the Applicant respectfully requests that the Examiner withdraw the rejection.

Further, the device disclosed in the '479 patent is an adjustable member for a seat back of a vehicle which transfers external mechanical or manual force to the seat back (Abstract). This is achieved by turning the shaft gradually into each desired direction by pumping a lever. (Col. 4, lines 58-60). Clearly, the invention of '479 is not foreseen to serve the purposes of the present invention--a heavy duty part incorporating an operational spindle having fast rotation for rotational work tools such as drills. The shaft of '479 is instead used to achieve the adjustments of the device, thereby transferring external mechanical force as disclosed in the Abstract. Further, the invention as disclosed in '479 requires use of a spring element (Col. 4, lines 58-60; Col. 6, Claim 1) as an integral part of its invention, thereby teaching away from the present invention. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

The Examiner has also rejected Claims 17, 25, 27 and 31 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,460,253 to Ritter et al. The Examiner indicated that Ritter includes "a spindle 27, a driven member 1,25 connected to the spindle, a freewheel having locking members 6,7, a ring 9 connected to the housing,

and a drive member having unlocking members 12a . . . the driven member and the drive member having torque-transmitting catch surfaces defined by surfaces 20,21 on cam surfaces of the drive member and surfaces 29,30 on catch opening in the driven member [wherein] [d]riven member 1 is shown as a sheet metal member". The '253 patent does not disclose a continuous, one-piece spindle nor a toothed gearwheel as a drive member supported thereon as claimed in sole independent claim 17, as amended, and therefore, all dependent claims. The Applicant respectfully traverses the rejections.

The Examiner has set forth in his rejection only a statement that the cited art ('253) includes certain elements set forth in the rejected claims which do not comprise the claims in their entirety. The Examiner has by no means addressed every element contained in the claims (for example, that the driven member is "fixedly connected to said spindle" and multiple other elements set forth within Claim 17, and therefore, contained within the remaining dependent claims) and as a result has not made a prima facie case for anticipation under §102(b) since the invention of the prior art cannot be the same invention unless every element described within the claims of the present invention are also described within the prior art citation. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 338, 86 S.Ct. 335 (1965). As a result, the Applicant respectfully requests that the Examiner withdraw the rejection.

Instead, the Examiner has indicated that "reciting the method of making the driven member does not carry patentable weight in these claims to the locking device". However, the placement of the driven member "fixedly connected to the spindle" as shown in Independent Claim 17 (and therefore all dependent claims) is important not in "reciting a method of making the driven member" as suggested by the Examiner, but rather in citing, as a feature of the claim, the relationship of the

driven member to the spindle, which is important in the operation of the claimed invention. Since the driven member is connected to the spindle, unlike with any of the other prior art citations, torque can be transmitted on either side of it along the spindle, such that the drive member (3, 3a, 3b) is a toothed wheel (7, 7a, 7b) supported on the spindle which can be utilized as a gearwheel. (Claim 17, as amended, and supported by the specification at page 4, lines 13 and 14.)

The Examiner has rejected Claims 27 and 31 under 35 U.S.C. §103(a) as obvious over Hochmuth et al. in view of U.S. Patent No. 5,551,927 to Enzmann et al. It is respectfully submitted that the Hochmuth reference as discussed above for the §102(b) rejection would be inappropriate for combining as a §103(a) rejection reference, given the disparity in the types of applications and differences in the invention, there is no suggestion or teaching offered for combining the '973 reference, a different art, with the Enzmann et al. reference. "Even if all of the elements of a claim are present in the prior art, the claim will not be obvious unless the prior art also contained, at the time the claim was filed, a motivation to combine prior art elements into the claimed invention." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340,1352 (Fed. Cir. 1998). Enzmann et al. actually teaches away from the present invention with its driven member fixedly attached to the single spindle since Enzmann et al. teaches the preferred use of multiple spindles (Col. 4, lines 51 to 67; Col. 6, lines 31 to 49). Given this preferred use of multiple spindles (and no mention of fixed attachment of the driven member, there would be suggestion to combine the reference to achieve such a result. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

The Applicant believes that all claims should now be in line for allowance. The Applicant has attempted to be fully responsive to the office action. However, if

the Examiner believes that such would be helpful, he is invited to telephone the undersigned to discuss the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Becker", with a stylized flourish at the end.

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